



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/178,329	10/23/1998	MICHAEL R. NOWAK	053649-0003	4360

7590

05/20/2004

Philip M Weiss, Esq.  
Weiss & Weiss  
310 Old Country Road, Ste. 201  
Garden, NY 11530

EXAMINER
----------

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
----------	--------------

1773

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/178,329

Applicant(s)

NOWAK ET AL.

Examiner

Monique R Jackson

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/2/04 has been entered.
2. Claims 1, 5, 6, and 8-12 are pending in the application. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1, 5, 6, and 8-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Finestone et al (USPN 5,244,702.) Finestone et al teach a paper-plastic laminate sheet capable of being converted by conventional equipment into envelopes, grocery bags, and other dilatable container products that initially are in a flat state and are normally made of paper and wherein the products produced are waterproof and the paper facing has an affinity for standard printing inks (Abstract; Col. 2, lines 10-26.) The laminate consists of a paper facing sheet laminated via an adhesive layer to a reinforcing film of oriented polymer such as polypropylene wherein the paper may be of any gauge, weight and quality as appropriate to the end use for which the sheeting is intended such as unbleached Kraft paper, white or colored paper or coated paper (Abstract; Col. 2, lines 66-Col. 3, line 9.) The adhesive layer is preferably a water-based polyacrylate copolymer adhesive or any other water-based adhesive having similar bonding properties and having an affinity both for the paper sheet and the plastic film wherein hot melt adhesives would diminish the reinforcing characteristics of the film (Col. 3, lines 28-38.)

Art Unit: 1773

Finestone et al do not teach that the paper has a basis weight of 20-60 lb/3000 sq ft as instantly claimed, however, Finestone et al do teach that the basis weight may be selected to be appropriate for a particular end use and that the laminate is suitable for products typically produced from flat paper materials, hence, given that ream wrap material is a typical product produced from flat paper materials, it would have been obvious to one having ordinary skill in the art at the time of the invention to determine the optimum basis weight based on the particular end use wherein basis weights within the instantly claimed range are known for producing ream wrap materials. Further, Finestone et al does not specifically teach adhesives as instantly claimed or metallization of the plastic film or the paper sheet, however, one having ordinary skill in the art at the time of the invention would have been motivated to provide a conventional metallized layer to improve barrier properties of the packaging laminate as is well known in the art and to further select from conventional adhesives utilized to bond paper and polymer layers such as those instantly claimed in producing the laminate taught by Finestone et al. In terms of instant Claim 10, the Examiner notes that though Finestone et al teaches away from utilizing heat when producing the laminate, the limitation "hot melt adhesive" is a process limitation wherein the adhesive layer in the final film is not actually hot. Therefore, considering the polyacrylate copolymer taught by Finestone et al as suitable in water-based form may also be characterized as a "hot melt adhesive" in other applications, the Examiner takes the position that the invention taught by Finestone et al reads upon the final product of Claim 10.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Art Unit: 1773

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 5, 6, and 8-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 20-23 and 33-36 of copending Application No. 10/385,117. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious for one having ordinary skill in the art at the time of the invention to combine various dependent claim limitations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Response to Arguments***

6. Applicant's arguments and Declaration filed 2/2/04 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson  
Primary Examiner  
Technology Center 1700  
May 17, 2004